REMARKS

Claims 1-9, all the claims pending in the application, stand rejected. New claims 10 and 11 have been added.

Claim Rejections - 35 U.S.C. § 103

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rieder (5,769,718). This rejection is traversed for three reasons. First, Rieder alone is inadequate to teach the claimed invention because it does not teach express claim limitations, as admitted by the Examiner. Second, the Examiner provides no underline documentary evidence that the missing features are well known in the art, as required by MPEP 2144.03 ("If applicant traverses such an assertion the Examiner should cite a reference in support of his or her position.") Third, the Examiner is simply wrong about what he believes (without any documentation) the game Street Fighter actually involves.

Rieder

The Examiner asserts that Rieder teaches a video game, having player characters, non-player characters and background images, which is operable in a plurality of modes assigned to the player characters and is able to generate images of the player character corresponding to the various modes as well as images of non-player characters with background images, as illustrated in Fig. 6. The Examiner asserts that Rieder teaches in the Summary at col. 2, line 11+ and cols. 5-8 with regard to Figs. 4-8 that the player character can have a weapon and can be in a moving state where it moves while carrying a weapon, with specific reference to Fig. 5.

The Examiner admits that the display of an image of a player character corresponding to any one operational mode, together with a non-player character, both kept unchanged while background images are controlled to display scenes adjacent to each other in a location, is NOT taught in Rieder. The admission is necessarily made because the Examiner asserts that such feature is "inherent."

The Examiner also admits that the feature in independent claims 1, 4, 7, 8 and 9 that requires restricting the switching of the background images from the start until the completion of an operational mode, as well as the features in dependent claims 2 and 5 relating to video RAM capacity and claims 3 and 6 relating to a fighting mode and a moving mode for the player

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character are NOT taught in Rieder. The admission is necessarily made because the Examiner asserts that they are either "inherent" or "well known."

The assertion that a feature is "inherent" requires that it must <u>necessarily exist</u>, and that no other alternative implementation could be possible (see **MPEP 2112** and citations to *In re Rijckaert* and *In re Oelrich*). As demonstrated subsequently, that is not the case as there clearly are many alternative ways and conditions for implementing a change of scenes or backgrounds and many ways to have fighting and moving modes. Moreover, as previously noted, the assertion that a feature is well known must be supported by documentation, according to MPEP **2144.03**. As demonstrated subsequently, no such documentation can even exist, as the Examiner's understanding of Street Fighter is in error.

<u>Street Fighter</u>

Claims 1, 4 and 7-9

The Examiner states at page 3 of the Office Action that a feature of displaying "a particular background (stage)...while characters are fighting" is taught in Street Fighter and asserts on this basis that the limitation of "restricting the switching of the background images from the start until completion of a predetermined particular operational mode" that appears in claims 1, 4, 7, 8 and 9, is "notoriously well known in the gaming industry." Neither the Examiner's comparison nor his analysis is accurate, as subsequently demonstrated.

In Street Fighter, the game is operative to switch a background image from one to another in two ways. Neither one applies to the present invention, as claimed.

<u>First Switching Way</u>

In a first one of the switching ways in Street Fighter, when a character is close to a vertical boundary of the screen and next <u>moves beyond the boundary</u>, the background image is switched from one image to another image. This shows that the switching of the background image is <u>dependent on the position of the opponent character</u>, and is NOT dependent on any <u>operational mode</u>.

On the other hand, switching the background image from one to another in the present invention <u>depends on an operational mode</u>, as determined by an action of a character. Background image does not depend on a position of a character. Consequently, Applicant submits that the switching way of the background image in the present invention is completely

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different from the first switching way in Street Fighter. In fact, they are opposites. Moreover, because of this significant difference (character position vs operational mode), the switching on the basis of a character position would not lead one of ordinary skill to switch by mode. Clearly, the Examiner cannot look to Street Fighter for anticipation or even a basis for obviousness of this feature of the claimed invention.

Second Switching Way

In the second one of the switching ways in Street Fighter, when a player character wins over the opponent and moves to another stage to fight another character, the background image is switched. In this case, it is assumed that the characters are kept in one operational mode during a battle and are shifted into another operational mode by moving from a previous stage to another one. In this case, however, a background image in the previous stage is completely different from a background image in a next stage. In other words, the background images in Street Fighter are discrete and independent from each other.

On the other hand, the background images in the present invention display scenes that "are adjacent to each other in location," as expressly stated in the preamble of Claims 1 and 4, and in the body of claims 7, 8 and 9. In other words, the "adjacent scenes" that are displayed represent portions of a single overall location (e.g., a battle ground) and are continuous to each other, as exemplified by the illustrations of Figs. 3-7 and as described at page 9 of the specification. Clearly, these "adjacent" scenes are closely related from the perspective of the user viewing the screen.

As mentioned above, in Street Fighter, background images switched between stages are obviously separate and distinct from each other, and do not represent continuous scenes. Additionally, a player of Street Fighter does not have to, nor can he/she manipulate his/her character while the character moves from one stage to another. Accordingly, even if some waiting time would occur while background images are being switched, such a waiting time does not affect the result of the game.

The above-mentioned difference between the present invention and Street Fighter has already been discussed in the remarks filed April 26, 2000. The Examiner appears to ignore this difference. Applicant respectfully requests the Examiner to contact the undersigned to discuss

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the merits of this difference, or to clearly explain in detail in any subsequent rejection the basis for concluding that this difference does not support a patentable distinction from the art. Applicant has demonstrated a difference and is at least entitled to the benefit of the Examiner's analysis so that this examination process can be concluded efficiently and effectively.

Claims 3 and 6

The Examiner also comments that the limitation of "the image of the player ... while carrying the weapon (claims 3 and 6)" is also "notoriously well known in the gaming industry," with apparent reference to features of Street Fighter. Applicant strongly disagrees with this comment.

According to claims 3 and 6, the fighting mode represents "a state wherein said player character is able to fight using said weapon", and "fighting mode is set as said particular operational mode." Consequently, with reference to the last subparagraph of claims 1 or 4, the changing of background images from the start until the completion of the fighting mode is restricted. Specifically, switching of background images is restricted when the character is able to fight using a weapon.
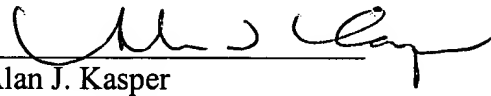
On the other hand, in Street Fighter, there is no restriction against switching background images on the basis of whether or not the character carries a weapon, or whether or not the character can fight using the weapon. In Street Fighter, there are two types of characters, those with weapons and without weapons. The switching operation of background images is common to both types of the characters. One of characters in Street Fighter, for example, can be equipped with a claw. Whether or not the character is currently equipped with that weapon has nothing to do with the switching of background images behind the character.

Applicant has added new claims 10 and 11, which now provide added detail related to this feature. In any event, these details are not necessary to clarify the difference between the present invention of claims 3 and 6, and the features of Street Fighter.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: August 19, 2002

APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 10 and 11 are added as new claims.